

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte CARY A. KIPKE and GEORGE VAN DYKE TIERS

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Appeal No. 1998-1827  
Application No. 08/644,932

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ON BRIEF

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Before, GARRIS, KRATZ, and DELMENDO, Administrative Patent Judges.

KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 2, 4-7 and 18-23 as amended after final rejection. No other claims are pending in this application.

BACKGROUND

Appellants' invention relates to a device for indicating the time of residence in a liquid disinfection solution. The

device includes a visually observable detector for furnishing evidence of the exposure of the device to a disinfection solution. See, e.g., the "Summary of the Invention" section at pages 3 and 4 of the specification. An understanding of the invention can be derived from a reading of exemplary claim 18, which is reproduced below.

18. A device for indicating residence time in a liquid disinfection solution, the device comprising a visually observable detector of exposure of the device to said solution, said device being selected such that upon exposure of the device to said solution said detector visibly changes after a predetermined time interval, the detector comprising a first visually apparent material that is water soluble and crosslinkable by a crosslinking component contained in said liquid disinfection solution, and a second visually apparent material that is soluble in said liquid disinfection solution, so that upon immersion of the device, the first material crosslinks to an insoluble state such that the first material, remains visually apparent in said device and the second material is dissolved in a visually apparent manner.

No prior art references of record are relied upon by the examiner in rejecting the appealed claims.

Claims 2, 4-7 and 18-23<sup>1</sup> stand rejected under 35 U.S.C.

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<sup>1</sup> The examiner inadvertently includes canceled claim 24 as a rejected claim in the 35 U.S.C. § 112, first paragraph

§ 112, first paragraph as containing subject matter which was  
not described in the specification in such a way as to  
reasonably

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rejections.

convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Claims 2, 4-7 and 18-23 stand rejected under

35 U.S.C. § 112, first paragraph on the ground that the specification is non-enabling. Claims 2, 4-7 and 18-23 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

We refer to the brief and to the answer for the opposing viewpoints expressed by appellants and the examiner concerning the above-noted rejections.

#### OPINION

For the reasons which follow, we will not sustain any of the examiner's rejections.

#### Rejection Under 35 U.S.C. § 112, second paragraph

The examiner has expressed a number of concerns regarding the claim language. See answer, page 5 for the statement of the examiner's rejection. However, the examiner has not carried the burden of explaining why the language of any of

the appealed claims, including claims 18 and 22, as that language would have been interpreted by one of ordinary skill in the art in light of appellants' specification, drawings and the prior art, fails to set out and circumscribe a particular area with a reasonable degree of precision and particularity.

The examiner's questioning of the structural relationship of the first and second material to each other and to the detector as recited in claim 18 and the examiner's questioning of how the recited positioning of claim 22 would enable the visual appearance of the first and second materials (answer, pages 5 and 7) appears to be premised on the examiner's concern with claim breadth and/or enablement rather than with the establishment of any actual ambiguity or indefiniteness of the language employed by appellants.

As explained by appellants (brief, pages 4 and 5), the claim language in question is reasonably definite. Here, we are in agreement with appellants' position since the examiner has not shown that the claims, in question, do not define appellants' device with a reasonable degree of precision and clarity, especially when read in light of appellants' specification.

In short, the examiner has apparently not given due regard to the principle that claims are not to be interpreted in a vacuum, but in light of information disclosed in appellants' specification and knowledge available in the prior art as understood by a person of ordinary skill in the art. See In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). Consequently, we will not sustain the rejection under 35 U.S.C. § 112, second paragraph.

Rejection under 35 U.S.C. § 112, first paragraph

On this record, we determine that the examiner has not met the burden of establishing a prima facie case under either the written description or enablement portions of the first paragraph of 35 U.S.C. § 112.

With regard to written descriptive support, all that is required is that appellants' specification reasonably convey to one of ordinary skill in the art that as of the filing date of the application, appellants were in possession of the presently claimed invention; how the specification accomplishes this is not material. See In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983); In re Edwards, 568 F.2d 1349, 1351-352,

196 USPQ 465, 467 (CCPA 1978); In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). Concerning this matter, it is not necessary that the application describes the presently claimed invention exactly, but only sufficiently clearly that one of ordinary skill in the art would recognize from the disclosure that appellants invented it. See Edwards, 568 F.2d at 1351-352, 196 USPQ at 467; Wertheim, 541 F.2d at 262, 191 USPQ at 96.

"The PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims." Wertheim, 541 F.2d at 263, 191 USPQ at 97.

Precisely how close the original description must come to comply with the § 112 written description requirement must be determined on a case-by-case basis. See Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1562, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991).

The examiner (answer, page 6) argues that appellants' specification does not provide support for the claimed device because "the specification and original claim 18, taken together, fail to fully describe the structural relationships

of various elements of the claimed embodiment." However, the examiner has not convincingly explained why, under the facts of the present case, the original disclosure, including original claim 18, fails to describe that subject matter which is recited in the appealed claims. The examiner has not established that the application, as originally filed, would not have reasonably conveyed to one of ordinary skill in the art that as of the filing date of the application, appellants were in possession of the claimed subject matter (see, e.g., specification, pages 3-16, the examples presented and original claim 18).

Moreover, for a proper rejection under the enablement provision of 35 U.S.C. § 112, it is incumbent upon the examiner to provide, in the first instance, factual evidence and/or scientific reasoning that one of ordinary skill in the art would be required to resort to undue experimentation to practice the invention as defined by the scope of the claims. See In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563-564 (CCPA 1982). In the present case, the examiner has presented no such persuasive evidence or reasoning which supports the conclusion that a skilled artisan would be unable



to practice the claimed invention without undue experimentation when using first and second visually apparent materials as herein claimed. See the portions of the specification referred to above. To the extent the examiner may have been concerned with claim breadth in that claim 18 does not set forth a particular positioning of the first and second visually apparent materials as the examiner apparently desires, we note that the mere possibility that a claim may cover an inoperable species does not render it unduly broad. See In re Kamal, 398 F.2d 867, 872, 158 USPQ 320, 324 (CCPA 1968).

We further note that appellants' position on this issue (brief, pages 3 and 4) is not effectively refuted by the examiner's commentary at pages 6 and 7 of the answer. In that commentary, the examiner appears to focus on other disclosed embodiments and, as a result, the examiner appears to confuse such other embodiments with the herein claimed embodiment as disclosed in original claim 18.

For the above reasons, we reverse the rejections under 35 U.S.C. § 112, first paragraph.

The decision of the examiner to reject claims 2, 4-7 and 18-23 under 35 U.S.C. § 112, first paragraph as lacking descriptive support in the specification, as filed; to reject claims 2, 4-7 and 18-23 under 35 U.S.C. § 112, first paragraph on the ground that the specification is non-enabling; and to reject claims 2, 4-7 and 18-23 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is reversed.

REVERSED

BRADLEY R. GARRIS	)	
Administrative Patent Judge	)	
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	)	
	)	
	)	BOARD OF PATENT
PETER F. KRATZ	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
ROMULO H. DELMENDO	)	
Administrative Patent Judge	)	

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APPEAL NO. - JUDGE KRATZ  
APPLICATION NO.

APJ KRATZ

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APJ

DECISION: **ED**

Prepared By:

**DRAFT TYPED:** 21 Jun 02

**FINAL TYPED:**